

ESTTA Tracking number: **ESTTA31905**

Filing date: **05/02/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<b>Proceeding</b>	92032341
<b>Party</b>	Defendant MICHEL FARAH  ,
<b>Correspondence Address</b>	David M. Rogero David M. Rogero, P.A. 2600 Douglas Road, Suite 600 Coral Gables, FL 33134 UNITED STATES dmrogero@dmrpa.com
<b>Submission</b>	Brief on Merits for Defendant
<b>Filer's Name</b>	David M. Rogero
<b>Filer's e-mail</b>	dmrogero@dmrpa.com
<b>Signature</b>	/s/David M. Rogero/
<b>Date</b>	05/02/2005
<b>Attachments</b>	Brief of Registrant 050205.pdf ( 16 pages )

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRAMIL S.R.L. (ESAPHARMA)	)	Opposition No. 92032341
	)	Mark: OMIC PLUS
Petitioner,	)	
	)	
v.	)	
	)	
MICHEL FARAH,	)	
	)	
Registrant.	)	
_____	)	

BRIEF OF REGISTRANT, MICHEL FARAH

May 2, 2005

David M. Rogero  
David M. Rogero, P.A.  
Attorney for Registrant  
2600 Douglas Road, Suite 600  
Coral Gables, FL 33134  
Telephone: (305) 441-0200  
Fax: (305) 460-4099

## TABLE OF CONTENTS

Table of Authorities .....	3
Description of the Record .....	4
Statement of Issues .....	5
Recitation of Facts .....	5
Argument .....	6
Summary .....	15
Certificate of Service .....	16

## TABLE OF AUTHORITIES

<i>Boyd's Collection, Ltd v. Herrington &amp; Company,</i> 2003 TTAB LEXIS 11 (2003) .....	7
<i>Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.,</i> 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) .....	7, 11
<i>Cunningham v. Laser Golf Corp.,</i> 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000) .....	7
<i>In re E.I. du Pont de Nemours &amp; Co.,</i> 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) .....	11
<i>Imperial Tobacco Ltd. v. Philip Morris Inc.,</i> 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990) .....	11
<i>Lucent Information Management, Inc. v. Lucent</i> <i>Technologies, Inc.,</i> 186 F.3d 311, 315 (3rd Cir. 1999).....	6
<i>Magic Wand Inc. v. RDB Inc.,</i> 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991) .....	7
<i>In re Majestic Distilling Co.,</i> 315 F.3d 1311, 1314-1315 (Fed. Cir., 2003) .....	11
<i>Martahus v. Video Duplication Services Inc.,</i> 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993) .....	7
<i>Paula Payne Prods. Co. v. Johnson Publ'g Co.,</i> 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973) .....	11
<i>Rivard v. Linville,</i> 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998) .....	11
<i>S Industries, Inc., v. Casablanca Industries, Inc.,</i> 2002 TTAB LEXIS 644 (2002) .....	7
<i>Stromgren Supports, Inc. v. Bike Athletic Company,</i> 43 USPQ2d 1100 (TTAB 1997) .....	11

### DESCRIPTION OF RECORD

Petitioner, Pramil S.R.L. (Esapharma), an Italian company, filed its petition to cancel the registration of the trademark OMIC PLUS on October 25, 2001. As grounds for its claim of damage resulting from the registration, Petitioner asserts that it manufactures and exports to the United States goods bearing the mark OMIC, and that its first sales in the United States took place prior to May 30, 2000, the date Registrant Michel Farah filed his application to register the mark OMIC PLUS. Petitioner alleges that there is a high likelihood of possible confusion in the minds of the purchasers as to the source of the goods bearing the two marks.

This case was the subject of numerous extensions of time. By order dated June 30, 2004, the Board set testimony periods that required Petitioner to complete its testimony by September 29, 2004, and Registrant to complete his testimony by November 28, 2004. Petitioner recorded the testimony of Jacob Aini on September 15, 2004, and after an extension of time, filed the transcript of Mr. Aini's testimony on October 26, 2004.

Registrant filed three motions to enlarge his testimony period. The first requested a thirty-day extension, through December 28, 2004. The second requested an extension through February 28, 2005, and was opposed by Petitioner. Finally, Registrant requested a third enlargement, through April 14, 2005, and was also opposed by Petitioner. At the time that the third request was made, the Board had not ruled on the prior two requests.

Although not reflected in the record, counsel for Registrant had written to counsel for Petitioner on March 1, 2005, expressing an intent to schedule Registrant's testimony during the month of March, but Petitioner's counsel did not respond. On March 18, 2005, Registrant noticed the taking of his testimony by deposition, scheduling it for March 29, 2005. Registrant's testimony was taken on that date, without knowledge that the Board had issued an order on

March 28 granting the first two requested extensions of the testimony period, but denying the last. The order effectively invalidated Registrant's prior notice of taking testimony, made while its motions for enlargement of time were pending.

Registrant has filed a motion for reconsideration, requesting that the denial of its last motion for enlargement of its testimony period be reversed and permitting the testimony scheduled and taken in good faith. Registrant's motion for reconsideration has not been ruled on by the time of the filing of this brief. The transcript of Registrant's testimony was filed on April 28, 2005.

#### STATEMENT OF ISSUES

- I. Whether Petitioner has established priority by a preponderance of the evidence.
- II. Whether Petitioner has established its continuous use by a preponderance of the evidence.
- III. Whether Petitioner has established likelihood of confusion by a preponderance of the evidence.
- IV. Whether Registrant has established priority.
- V. Whether Petitioner's products can be legally distributed in the United States.

#### RECITATION OF FACTS

Registrant Michel Farah registered his trademark OMIC PLUS for use in connection with certain cosmetics, in International Class 3, based upon a claimed date of first use in commerce of November 1990. His application to register this mark was filed on May 30, 2000, and the application was published for opposition on February 6, 2001. As no opposition was filed, the

mark was registered on the Principal Register on May 1, 2001, and was assigned Registration Number 2447970. This cancellation proceeding was filed on October 25, 2001.

Petitioner seeks the cancellation of the registration on the claims that Petitioner made prior use of its claimed mark OMIC, and that there exists a likelihood of confusion. Petitioner's evidence and testimony is presented through one witness, Jacob Aini, a self-described "agent" for the Petitioner. Through Mr. Aini's testimony, the Petitioner attempts to show use of its mark as early as 1994.

The proffered testimony of the Registrant, Michel Farah, shows his use of the registered mark since 1990, and establishes that the products the Petitioner produces under its claimed mark are distributed illegally in the United States.

### ARGUMENT

#### Preliminary Statement.

In a cancellation proceeding, the respondent's registration is presumed to be valid, and the petitioner must rebut this presumption by a preponderance of the evidence. *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Gibson Guitar Corp. v. J. D'Addario & Co., Inc.*, Cancellation Nos. 92041175 and 92041688, 2005 TTAB LEXIS 63 (TTAB 2005).

Here, the petitioner raises issues of priority and likelihood of confusion. The petitioner fails to carry its burden of proof on these issues and its cancellation must be refused. In addition, Registrant's evidence establishes his prior use, and he should prevail in this matter.

I. Petitioner has failed to meet its burden of proof to support its claim of priority.

Because the Petitioner does not claim a registration of its mark, it can only assert a priority date based upon its first use in commerce. *Lucent Information Management, Inc. v. Lucent Technologies, Inc.*, 186 F.3d 311, 315 (3rd Cir. 1999). Section 7(c) of the Lanham Act states that “the filing of an application to register [a mark] shall . . . confer[ ] a right of priority, nationwide in effect, . . . against any other person except for a person . . . who, prior to such filing, has used the mark” 15 U.S.C. § 1057(c). Consequently, Petitioner must establish rights in its claimed mark OMIC by its prior “use [of the mark] in commerce”—“use” being defined as “the bona fide use of a mark in the ordinary course of trade. . . .” 15 U.S.C. § 1127. *Id.*

In Board proceedings, the plaintiff must establish its pleaded case, as well as its standing, and must generally do so by a preponderance of the evidence. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); and *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

*S Industries, Inc., v. Casablanca Industries, Inc.*, 2002 TTAB LEXIS 644 (2002).

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “use in commerce,” in part, as follows:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--

(1) on goods when--

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce . . .

The evidence presented by the Petitioner, through its sole witness, Jacob Aini, falls short of proof of prior “use” by a preponderance of evidence. Mr. Aini testifies that he is “involved”



with a company identified as I.C.E. Marketing. (Aini, p. 5, lines 18-22). Mr. Aini states that he is the agent of “Esapharma S.P.R.L. of Italy,” which Mr. Aini states is the same company as Pramil S.R.L. (Aini, p.5, lines 23-25, p. 7, lines 1-11). Mr. Aini states that “we” are the exclusive agents of Pramil in the United States, Canada, Jamaica, Trinidad and Haiti. (Aini, p. 11, lines 23-35, p. 12, lines 1-8).

Mr. Aini states that he is familiar a product by the name of Omic, and that he has been involved with this product in the United States since 1994. (Aini, p. 6, lines 19-25). Mr. Aini testifies that Pramil began exporting the Omic product into the United States in about 1994. (Aini, p. 15, lines 1-6).

Petitioner’s documentary evidence of its claimed first use of its Omic brand in the United States is an invoice from Zuri International in Brooklyn, New York, to “Tex Int’l” in Miami Lakes, Florida, dated May 13, 1994. (Petitioner’s Exhibit 1). According to Mr. Aini, the invoice shows products sold “that had Omic on it.” (Aini, p. 18, lines 11-14). Mr. Aini also states that the product was produced by Pramil. (Aini, p. 19, lines 3-5). Mr. Aini does not, however, offer any testimony whether such goods were offered to the public for sale, nor does his testimony provide any information about the use of Petitioner’s claimed mark on these goods. Mr. Aini does not testify about any connection between the purported seller of the goods, Zuri International, and the Petitioner, nor about any license or authorization from Petitioner, the purported owner of the mark, and either Zuri International or Tex Int’l.

Further, upon cross-examination, Mr. Aini permitted that he had no actual knowledge of the receipt of the listed goods in Miami (Aini p. 61, lines 6-10; p. 62, lines 5-12), and that nine of the twelve cartons of Omic goods were returned to Milan (Aini p. 62, lines 20-25; p. 63, lines 1-

8, 21-23). Mr. Aini had no knowledge whether goods received by Tex International were distributed. (Aini p. 63, lines 24-25; p. 64, lines 1-13).

While Mr. Aini's testimony about Exhibit 1 may support the fact that a sale of goods, identified in an invoice as Omic, occurred in 1994, the testimony and evidence does not establish the placement of a mark on the goods or their containers, or the Petitioner's involvement in the transaction, other than as the producer of the goods. Thus, the evidence and testimony surrounding Petitioner's Exhibit 1 does not establish use by Petitioner in commerce.

Petitioner's Exhibits 2, 3 and 11 are identified by Mr. Aini as invoices reflecting the sales of Omic products by Petitioner to Premiere Wholesale Inc. in Brooklyn, New York, in June of 1995 and in February of 1996 (Aini, pp. 20-23; p. 24, lines 1-5) and to I.C.E. Marketing Inc, in New York in May of 2000 (Aini p. 36, lines 4-18).<sup>1</sup> In the course of his testimony, Mr. Aini states that he is "familiar" with the first invoice and that the invoices represented in Exhibits 2 and 3 were "in [his] records" (Aini, p. 21, lines 8-11; p. 23, lines 22-24). This testimony fails to authenticate the writings offered as Petitioner's Exhibits 2, 3, and 11, and their admission into evidence cannot be allowed. *See* Rule 901, Federal Rules of Evidence; 37 C.F.R. § 2.122(a).<sup>2</sup> Moreover, as with Exhibit 1, the Petitioner did not offer any testimony as to Petitioner's placement of its claimed mark OMIC on the goods described in these three invoices.

In fact, the only evidence concerning Petitioner's placement of its claimed mark on goods or their containers is found in Petitioner's Exhibits 13 and 14. Mr. Aini testifies that the product

---

<sup>1</sup> Mr. Aini identified Petitioner's Exhibit 10 as a duplicate of Exhibit 3. (Aini p. 33, lines 24-25; p. 34, lines 1-16).

<sup>2</sup> Registrant preserved objections to Petitioner's exhibits on grounds of lack of predicate and hearsay. (Aini p. 44, lines 12-17). On cross-examination, Mr. Aini consistently admitted his lack of personal knowledge as to facts reported in these documents. (Aini pp. 65 through 69; pp. 82 through 86).

carton depicted in Exhibit 13 is the one “we are distributing . . . in the U.S.” (Aini p. 39, lines 14-18). Mr. Aini use of the present tense confirms use at the present time, but his testimony does not establish that this or any other container was in use at any prior time. The only testimony regarding Petitioner’s application of a mark on the goods identified in the 1994, 1995 and 1996 invoices is Mr. Aini’s testimony that the “geometric figure with an E in the middle” is the “same E that is on the product on the invoice from back to ‘94” (Aini p. 39, lines 22-25; p. 40, lines 1-3). Mr. Aini testifies that the packaging shown in Petitioner’s Exhibits 13 and 14 are the “types of packages that are presently being marketed today” (Aini p. 42, lines 5-8), but his testimony offers no clue as to the placement of Petitioner’s claimed mark OMIC on goods allegedly sold prior to 2002.

Petitioner’s Exhibits 7, 8, 9, 12 and 15 are of no import to the issue of priority, as they are offered as evidence of sales of goods by Petitioner after the filing of Registrant’s application on May 30, 2000. Petitioner’s remaining Exhibits 4, 5, and 6 do not evidence any use in commerce by the Petitioner.

Although Petitioner offers a few invoices, dated prior to the date of Registrant’s filing of his application to register his mark OMIC PLUS, that purport to show shipments of goods identified as “Omic,” the Petitioner has produced no evidence that it applied its claimed mark to any of the goods, and has thus failed to meet its burden to prove prior use of the mark in commerce. Accordingly, its petition to cancel the registration of Registrant’s mark must fail.

## II. Petitioner has failed to meet its burden of proof to establish its continuous use.

Taking all of Petitioner’s evidence as to its use of its claimed mark OMIC as true, the Petitioner offers evidence, through Petitioner’s Exhibits 1, 2, 3, 7, 8, 9, 11, 12 and 15, of

shipments of goods from 1994 to 1996 and from 2000 to 2004. Despite Mr. Aini's claim that sales of such goods never ceased or were abandoned (Aini p. 29, lines 11-13), no testimony is offered to explain the four-year gap from 1996 to 2000.

Section 45 of the Trademark Act provides, in pertinent part, that a mark is abandoned when the following occurs:

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment.

Thus, Petitioner's own evidence of nonuse of the mark for more than three consecutive years constitutes a prima facie showing of abandonment, from which intent not to resume use is inferred. Petitioner has the burden to show either evidence sufficient to disprove the underlying facts showing three years nonuse, or evidence of an intent to resume use to overcome the presumed fact of no intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); *Stromgren Supports, Inc. v. Bike Athletic Company*, 43 USPQ2d 1100 (TTAB 1997). While Petitioner's evidence, if accepted at face value, shows the resumption of use of its claimed mark, Petitioner offers no evidence to overcome the presumed abandonment during the four-year period of non-use.

Petitioner's failure to document its continuous use of its claimed mark, and its failure to overcome the presumption of abandonment, are fatal to Petitioner's request for cancellation of Registrant's mark.

III. Petitioner has failed to meet its burden of proof to establish likelihood of confusion.

It is Petitioner's burden to prove likelihood of confusion by a preponderance of evidence in order to prevail in this cancellation proceeding.

Likelihood of confusion is determined by focusing on the question whether the purchasing public would mistakenly assume that the Registrant's goods originate from the same source as, or are associated with, the goods of the Petitioner. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 1314-1315 (Fed. Cir., 2003); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973). That determination is made on a case-by-case basis, aided by the application of the factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Those factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark . . . .
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used . . . .
- (10) The market interface between the applicant and the owner of a prior mark . . .

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

(12) The extent of potential confusion . . . .

(13) Any other established fact probative of the effect of use.

Id. at 1361, 177 USPQ at 567.

Petitioner's sole witness, Mr. Aini, offered no testimony or evidence to support a claim of likely confusion. In fact, Petitioner's counsel specifically prevented Mr. Aini from answering a question about confusion. (Aini, p. 89, lines 22-25; p. 90, lines 1-15). Thus, Petitioner offers no evidence that can be used for application of any of the *du Pont* factors.

Instead, Petitioner attempts to fashion arguments without the benefit of any supporting evidence. Touching on but one of the *du Pont* factors, Petitioner argues "we are not dealing here with the 'sophisticated consumer,' but rather the impulse buyers who typically shop the aisles or store displays and then select products such as cosmetics, soaps, creams and gels." (Petitioner's Brief, p. 7). Petitioner has offered no evidence to support this assertion. Petitioner also argues that the goods of Petitioner and Registrant are identical, but cites no evidence to support the claim.

In the complete absence of evidence or testimony on the topic, Petitioner has failed to meet its burden of proof to show a likelihood of confusion. To the contrary, the lack of any evidence of actual confusion during at least five years of concurrent use shows that at least one *du Pont* factor weighs against a finding of likelihood of confusion. Without evidence to support a finding of a likelihood of confusion, Petitioner's request for cancellation is unwarranted, and must be denied.

IV. Registrant has established its priority.

Registrant has filed and offers his testimony to support the fact that Registrant's use of the mark OMIC PLUS preceded any use claimed by Petitioner. The reasons supporting this Board's consideration of this testimony are set out in Registrant's pending motion for reconsideration of the order denying his last request for additional time. The determination of the issues in this proceeding without consideration of all pertinent facts offered by the parties would be an injustice.

Simply put, the testimony of Michel Farah demonstrates, through related and controlled companies, his use in commerce of goods bearing the mark OMIC PLUS beginning in 1990 and through the present. (Farah pp. 4 through 20, Registrant's Exhibits 2 through 17). Such use clearly defeats Petitioner's claim of priority, and requires the denial of the petition to cancel the registration.

V. Petitioner's products cannot be legally distributed in the United States.

In his testimony, Mr. Farah identifies the Petitioner's product, and testifies that it contains a corticosteroid that is not permitted for over-the-counter sale in the United States. (Farah p. 20, 17-25; p. 21, lines 1-25; p. 22, lines 1-13). A container of one of Petitioner's products, Registrant's Exhibit 18, shows the ingredient Fluocinonide, which is a topical corticosteroid requiring a physician's prescription for sale in the United States. *See* Class Labeling Guideline, Department of Health and Human Services, Food and Drug Administration, 46 FR 49205 (October 6, 1981). Under section 45 of the Trademark Act, 15 U.S.C. §1127, use in commerce requires "bona fide use." As Petitioner's over-the-counter distribution of its goods bearing its claimed mark is prohibited by federal law, its use is not bona fide. Petitioner's distribution of

such products over the counter is illegal, and cannot constitute use upon which trademark rights can be predicated. Accordingly, Petitioner has no standing to seek cancellation of the registration of Registrant's mark, as its claimed use of its mark cannot qualify to afford it any prior rights.

### SUMMARY

Petitioner has failed to carry its burden of proof that it had established prior use of its claimed mark, that its use was continuous and not abandoned, and that there is a likelihood of confusion. Further, Registrant has established that he is the prior use of his mark in commerce, and that Petitioner has applied its claimed mark to goods distributed in violation of federal law. For these reasons, the petition to cancel the registration of the mark OMIC PLUS must be denied.

Respectfully submitted,

/s/David M. Rogero/  
David M. Rogero  
Fla. Bar No. 212172  
David M. Rogero, P.A.  
2600 Douglas Road, Suite 600  
Coral Gables, FL 33134  
Telephone: (305) 441-0200  
Fax: (305) 460-4099

May 2, 2005



CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Brief of Registrant was sent by first class mail with proper postage affixed, the 2nd day of May, 2005, to the following counsel:

Donald L. Dennison  
Attorney for Pramil S.R.L. (Esapharma)  
Dennison, Schultz & Dougherty  
1727 King Street, Suite 105  
Alexandria, VA 22314

/s/David M. Rogero/